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09/830,841	05/01/2001	Fiorenzo Renzi	GL-12(GL-01-8)	3592

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EXAMINER

ACQUAH, SAMUEL A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/17/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 15

Application Number: 09/830,841
Filing Date: May 01, 2001
Appellant(s): RENZI ET AL.

MICHAEL W. FERRELL
For Appellant

EXAMINER'S ANSWER

MAILED
JAN 17 2003
GROUP 1700

This is in response to the appeal brief filed 09/03/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-26 have been substituted for the finally rejected claims.

Claim 25 has been amended subsequent to the final rejection.

Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 09/03/02 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

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Appellant's brief includes a statement that claims 1-27 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,970,293

RENZ1 et al

11-1990

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Renzi et al '293. Please see the Final Rejection, paper number 7, for a statement of the rejection.

(11) *Response to Argument*

Claim 1 is the only independent claim and is drawn to a liquid composition which is polymerizable by radical polymerization with low shrinkage, into organic glasses, and comprises a reaction product obtained from the transesterification of three components: (A) a diallylcarbonate with a mixture of (B), one or more linear or branched aliphatic diols having three to ten carbon atoms, and (C), a linear or branched aliphatic polyol having four to twenty carbon atoms and three to six hydroxyl groups. The molar ratio (A) / (B+C) ranges from 2.5/1 to 4/1, and the quantity of (C) in the mixture (B+C) ranges

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from 5% by weight to 20% by weight, with respect to the total weight of the mixture (B+C).

The cited, common-inventor patent discloses a liquid composition polymerizable by free radical polymerization with low shrinkage into organic glasses, by transesterification of a diallylcarbonate (A) with a mixture of diol (B) and a polyol (C) containing 3 to 6 hydroxyl groups; or a mixture of diol (B) with a cycloaliphatic diol (C'). The molar ratio $A/(B+C)$ or $A/(B+C')$ is equal to, or greater than 3/1. The amount of (C) in the (B+C) mixture is from 20-60% by weight, and (C') in the (B+C') mixture is from 20-80% by weight, see claim 4 of the cited prior art. Thus, the cited prior art discloses all the components as claimed. The limitations of all the dependent claims 2-26 are all disclosed by the prior art. The only remaining issues are the relative amounts and ratios of the various components. It is Appellants position that the cited prior art is different because:

It is clear from the portion of the *Renzi et al.* disclosure cited by the Examiner...that no single species, i.e., specific composition which would unequivocally anticipate Appellants' claimed composition, is identified by such disclosure. Rather, this disclosure merely describes ranges of materials which touch or overlap the claimed range.

Appellants then point to the section of the MPEP, Section 2103.03, which indicates that:

When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute. What constitutes a "sufficient specificity" is fact dependent.

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In the case herein, the prior art discloses the same composition which is polymerizable by free-radical transesterification to form organic glasses of low shrinkage. The components A, B, and C disclosed by the prior art are the same as claimed. See columns 1-4. **The sole question is whether the prior art disclosed said components in the amounts as claimed.** Patentees clearly disclose that the ratio $A/(B+C)$ is equal to or greater than $3/1$ (Appellants claim $2.5/1$ to $4/1$). Then patentees disclose in Table 1, in column 9, examples 1 and 4 wherein the ratio $DAC/(PE + DEG)$, which is the same as $A/(B+C)$, is $4/1$. Furthermore, patentees claim in claim 1 the ratio $(A)/(B+C)$ being $3/1$ - $12/1$. Thus, based on the facts of the case, the prior art has clearly disclosed all the components of the claimed composition, has disclosed and claimed the ratios as claimed, and has provided examples which include the claimed ratios. Thus, the prior art has disclosed the claimed subject matter with "sufficient specificity".

With respect to the other claimed amount of $(C)/(B+C)$, while Appellants claim an amount of 5-20% by weight, the cited prior art discloses and claims an amount of 20-60% by weight. Thus, both patentees and Appellants claim an amount of 20% by weight.

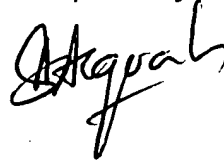
The dependent claims 2-26 are all met by the prior art, and Appellants do not argue separate patentability.

Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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S.A.A

December 19, 2002

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